

REMARKS

This is a full and timely response to the Restriction Requirement mailed July 3, 2003.

In the Restriction Requirement, the present examination is to be restricted to a smart card as recited in Claim Group I (claims 1-19 and 27-31) or a set-top box using a smart card as recited in Claim Group II (claims 20-26).

In response, Applicant hereby elects Claim Group I, claims 1-19 and 27-31, for immediate prosecution. Consequently, claims 20-26 are indicated herein as being withdrawn from consideration. However, this election is made with traverse.

In support of the Restriction, it is argued that the inventions of Group I and Group II “are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations.” (Restriction, p. 2).

The Action then gives an incomplete sentence as the rationale for the Restriction: “In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a smart card” (Restriction, p. 2). Consequently, Applicant is unsure what the rationale is that supports the Restriction.

In actuality, however, the combination *does* require the particulars of the subcombination as claimed for patentability. The combination recited in claim 20 is the combination of a set-top box and the smart card of claim 1. The subcombination is the smart card which is recited independently in Claim Group I.

Claim 20 recites “a set-top box comprising: a connector for connecting to a cable television system; and a smart card removeably connected to said set-top box, wherein said

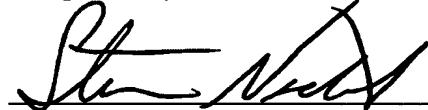
smart card stores programming for use by said set-top box in a processing and memory circuitry.” The remainder of the claim then recites the novel features of the smart card as also recited in claim 1.

Consequently, there are no novel details recited in the set-top box of claim 20. Rather, the novelty is in the subcombination, i.e., in the smart card, which is also recited independently in claim 1. Thus, the combination (the set-top box plus the smart card) as claimed requires the particulars of the subcombination (the smart card) as claimed for patentability.

Therefore, under M.P.E.P § 806.05(c), as cited in the Office Action, the claim groups have not been shown to be independent for purposes of a Restriction Requirement and the Restriction that has been made is improper. Consequently, Applicant respectfully requests that the current Restriction Requirement be reconsidered and withdrawn and that all claims in the application receive an immediate examination.

Moreover, for the reasons given in the amendment filed April 17, 2003, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper, which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013/80113-0230 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



Steven L. Nichols
Registration No. 40,326

DATE: 28 July 2003

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)